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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,432	10/20/2003	Julianne Bielski	RPS920030021US1	2798
83227 7590 06/23/2010 LAW OFFICE OF JIM BOICE 3839 Bee Cave Road Suite 201 WEST LAKE HILLS, TX 78746				
EXAMINER RICEK, JASON D				
ART UNIT 2442		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/689,432

Applicant(s)

BIELSKI, JULIANNE

Examiner

JASON RECEK

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,11-14,16 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11-14,16 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on March 18th 2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***./John Follansbee/

Supervisory Patent Examiner, Art Unit 2451

Status of Claims

Claims 1-3, 5-9, 11-14, 16 and 22-24 are currently pending.

Response to Arguments

1. Applicant's arguments concerning claims 1-3, 5-9, 11-14 and 16 (pg. 7-11) have been fully considered but they are not persuasive. Applicant asserts the management server of Hanson acquires the IP address directly from the DHCP server and not from the client (mobile end system). This is not persuasive. Hanson does not teach the "listeners" are part of the management server as suggested by applicant. Instead Hanson explicitly discloses that the end system and management server "coordinate together" to ensure the server recognizes the end system's address (paragraph 287). Any suggestion that this implies something other than the end system communicating directly with the server to inform it of the received address is misconstruing the reference. In order for the end system to coordinate (communicate) with the server it must have some way of addressing it. DHCP and BOOTP allow a host to receive an IP address including option data as outlined in the DHCP RFC (see Hanson paragraph 286). Doherty explicitly discloses sending the address of a management server from a DHCP server to a host (mobile end system) in order for the host to contact the management server. This combination discloses the claim limitations.
2. Applicant's arguments (pg. 11-12) concerning claim 22 are similar and therefore not persuasive for similar reasons.
3. Applicant's arguments, see pg. 12, with respect to the rejection(s) of claim(s) 24 have been fully considered and are persuasive. Therefore, the rejection has been

withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Khaki et al. US 6,067,569.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-14 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claim 12, it is a computer readable/storage medium claim. The broadest reasonable interpretation of such a claim covers forms of non-transitory media and transitory signals. Signals are not patentable subject matter. Therefore the claim is rejected as covering non-statutory subject matter. Please amend the claim to recite "a non-transitory computer storage medium ...". This will clarify the claim is only directed to patentable subject matter. Claims 13-14 and 16 are rejected based upon their dependency.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 recites the limitation "the DHCP server" in line one.

There is insufficient antecedent basis for this limitation in the claim. The IP issuing computer of claim 1 may use DHCP but it is not clear that it is a DHCP server.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5, 7-9, 11-14, 16 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. US 2003/0120811 A1 in view of Doherty et al. US 2003/0018763 A1.

Regarding claim 1, Hanson discloses "providing an internet protocol (IP) address" as using a DHCP server to provide clients with a network address (paragraph 286), "configuring an IP address issuing computer to include a plurality of IP addresses ... to be assigned to at least one remote management processor which is coupled to a remote hardware server" as a DHCP server that issues IP address to clients (management processor) which are connected to a remote management system (Fig. 1, paragraphs 286-287). Examiner searched for a definition of "management processor" in the specification only to find a brief description of it in the background section (pg. 1). Since the client disclosed by Hanson contains a processor that is coupled to a

management server, the client disclosed by Hanson is a reasonable interpretation of the term "management processor". Hanson also discloses "Option data comprises an IP address of a management server" as configuration information that allows a client to connect to a management server (paragraph 287), "hardware resources" as the computer system described would necessarily contain hardware (Fig. 1);

"sending a request from the ... processor to the IP address issuing computer" as sending a DHCP request (paragraph 286);

"in response to the request, receiving from the IP issuing computer ... the requested IP address" as receiving an available address (paragraph 286), "and the Option data" as configuration information (paragraph 287); and

"in response to the detecting of the Option data, automatically sending the alert packet ... such that the alert packet comprises the received requested IP address" as the end system and the management server coordinate together to ensure the server is aware of the issued IP address (paragraphs 287-288).

Hanson does not explicitly teach,

"in response to receiving the acknowledgment ... storing in the remote management processor, as a destination address for sending an alert packet, the received IP address of the management server" however this is taught by Doherty as receiving a file from the DHCP containing multiple destination addresses including the management server's address (paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to store the information received from

the DHCP server for future use. Hanson teaches this information allows communication (paragraph 287) but does not explicitly teach what is included or that it is stored. Doherty is cited for showing the DHCP interaction in more detail and thus the combination is merely following the DHCP RFC which outlines the complete protocol.

The combination of Hanson and Doherty does not explicitly disclose "the alert packet further comprises a shelf life of the received requested IP address" however Hanson does teach (paragraph 286) that the received IP address has a lease duration (i.e. shelf life) and that the end system informs the management server of the received IP address (paragraph 287). It would have been obvious to one of ordinary skill in the art at the time of the invention to inform the management server of the lease duration as well. The purpose of the management server is to manage the remote system. Once the IP address expires the management server will no longer be able to contact the remote system directly. Thus, it would have been obvious to inform the management system of the IP address' lifetime for the purpose of managing.

Regarding claim 2, Hanson discloses "the management server stores information ... includes the IP address assigned to the at least one remote management processor" as a management server recognizing the end system's (processor) network address (paragraph 287), and "a shelf life of the assigned IP address" as the address is assigned for a specific period (lease duration) this is equivalent to a shelf life (paragraph 286).

Regarding claim 3, Hanson discloses “the IP address issuing computer is a DHCP server” (paragraph 286). Hanson does not explicitly disclose “the management server is running a management server software package to manage the at least one remote management processor” however this is taught by Doherty as a management server that has software for managing client requests (paragraphs 39-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Hanson with the management software of Doherty for the purpose of managing. Hanson teaches a management server, the addition of management software is merely the combination of known elements according to their established function that yields a predictable result.

Regarding claim 5, Hanson discloses “sending of the request ... is automatically prompted by ... being powered on” as sending a request at boot time (paragraph 286).

Regarding claims 7-9 and 11, they are system claims that correspond to the method of claims 1-3 and 5 respectively. Therefore they are rejected for similar reasons.

Regarding claims 12-14 and 16, they are medium claims that correspond to the method of claims 1-3 and 5 respectively. Therefore they are rejected for similar reasons.

Regarding claim 22, it is a method claim that corresponds to claim 1, therefore it is rejected for similar reasons.

Regarding claim 23, Hanson discloses "identifying which IP addresses the DHCP server is authorized to assign" as the DHCP server has a pool of available addresses (paragraph 286).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson and Doherty as applied to claims 1-5 above, and further in view of Giglio et al. US 2004/0039821 A1.

Regarding claim 6, Hanson and Doherty do not explicitly disclose "an administrator of the management server defines the Option data" however this is taught by Giglio as manual configuration of network information (paragraph 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to manually configure certain network information as taught by Giglio for the purpose of setting up a network. Manual configuration is well known in the art and yields predictable results.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hanson and Doherty in further view of Khaki et al. US 6,067,569.

Regarding claim 24, the combination of Hanson and Doherty does not explicitly disclose "alert packet is transmitted from said at least one remote processor without said at least one remote processor's use of an operating system" however this is taught by Khaki as a network card performing forwarding (transmitting) without using the central processing unit (col. 2 ln. 59 - col. 3 ln. 8, and claim 24). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Hanson and Doherty with the fast-forwarding feature taught by Khaki for the purpose of transmitting data. Khaki teaches that by eliminating the overhead of involving the CPU / operating system routing / forwarding speed is improved (col. 3 ln. 60—col. 4 ln. 11).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaneda et al. US 2003/0212781 A1 discloses an information processing unit that sends its IP address obtained from a DHCP server to the management unit (paragraph 16).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Fri 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached on (571) 272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Recek/
Examiner, Art Unit 2442
(571) 270-1975

/Philip C Lee/
Acting SPE of Art Unit 2442